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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,986	03/15/2001	Michael Ilmer	99 P 5524	5171

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Osram Sylvania Inc
100 Endicott Street
Danvers, MA 01923

EXAMINER

BERCK, KENNETH A

ART UNIT PAPER NUMBER

2879

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,986

Applicant(s)

ILMER ET AL.

Examiner

Ken A Berck

Art Unit

2879

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Amendment C, filed Mar 10, 2003, has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Vollkommer et al. (US 6531822).

Vollkommer discloses a dielectrically impeded discharge lamp with a discharge vessel having electrodes and two at least partially parallel vessel walls, at least one electrode being separated from the interior of the discharge vessel by a dielectric, a spacer made from an optically transparent insulating material and having a spherical shape, the spacer having an optically diffuse surface and being arranged inside the discharge vessel between the two vessel walls and in contact with the two vessel walls

via bearing surfaces and a hemisphere of the spacer being coated with a fluorescent material, the hemisphere being oriented in such a way that its pole lies inside a bearing surface.

Regarding claim 25, the coating of fluorescent material is at least thinner on the bearing surface.

Regarding claim 26, the spacer being formed of glass or ceramics, which has the properties of being made of microstructures.

Regarding claim 27, at least a portion of the surface of the spacer has an anti-reflection interference layer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28-35 rejected under 35 U.S.C. 103(a) as being unpatentable over Vollkommer et al. (US 6531822) in view of Veres (US 3734702).

Vollkommer discloses all of the above claim limitations but fails to clearly point out the white pigment in the glass being rutile (TiO_2) and the proportion of the white pigment in the glass solder is in the range from approximately 1% by weight to 10% by weight and the spacer having a cruciform or star-shaped cross section.

Regarding claims 28-29 and 33, Veres discloses the white pigment in the glass being rutile (TiO_2) and the proportion of the white pigment in the glass solder is in the

range from approximately 1% by weight to 10% by weight in order to allow for more time for sealing parts without developing a seal with uneven stress concentration due to crystallization.

Hence it would have been obvious to use the lamp of Vollkommer with the glass being rutile (TiO_2) and the proportion of the white pigment in the glass solder is in the range from approximately 1% by weight to 10% by weight in order to allow for more time for sealing parts without developing a seal with uneven stress concentration due to crystallization, as taught by Veres.

Regarding claim 32, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the spacer to have a cruciform or star-shaped cross section, since such a modification would have involved a mere change in shape of a component, which is generally recognized as being within the level of ordinary skill in the art.

Claims 30-31 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vollkommer et al. (US 6531822).

Regarding claims 30 and 34, applicant is claiming process step therein and therefore are of product-by-process nature. The courts have been holding for quite some time that: "—In spite of the fact that a product-by-process claim may recite only process limitations, it is the product which is covered by the claim and not the recited process steps—. (In re Hughes, 182 USPQ 106)—". Also —Patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious. (In re

Pilkington, 162 USPQ 147)--." Accordingly, "--a rejection based on 35 U.S.C. section 102 or alternatively on 35 U.S.C. section 103 of the statute is eminently fair and acceptable." (In re Brown and Saffer, 173 USPQ 685 and 688). --The determination of the patentability of product-by-process claim is based on the product itself rather than on the process by which the product is made--. In re Thrope, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). As such, no patentable weight is given to process steps recited in claims 30 and 34.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken A Berck whose telephone number is (703)305-7984. The examiner can normally be reached on Mon-Fri 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be reached on (703)305-4794. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7382 for regular communications and (703)308-7382 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

kab *163*
June 11, 2003

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